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REMARKS

Claims 1-32 are pending. Claims 1 and 17 are amended. The Examiner rejected claims 1-32 under 35 U.S.C. § 103(a). The applicant respectfully traverses the rejections and requests reconsideration in view of the remarks herein.

The Examiner rejected claims 1-8, 11, 13, 17-24, 26, 27 and 29 under 35 U.S.C. § 103(a) as being unpatentable over US Patent Publication No. 2003/0062202 ("Parry") and further in view of US Patent No. 6,873,715 ("Kuo").

Claims 1-16

Claim 1 recites a method for signing an electronic document. In particular, the claim provides for establishing an electronic signature appearance for an electronic signature. The first limitation of the claim defines an "electronic signature appearance" as comprising a visual manifestation of a signer's signature on the electronic document. The specification further clarifies the difference between an electronic signature and an electronic signature appearance. In the Background at page 1, lines 26-28, the term "electronic signature" is defined as the "code derived from the signed electronic document and a given private key". The term "electronic signature appearance" is defined as a "visual manifestation of the signer's signature on the electronic document", which is consistent with the wording in claim 1.

Claim 1 further provides in the third limitation the following:

at the time of electronically signing an electronic document, previewing the electronic signature appearance in the bounding region, where the electronic signature appearance can be edited based on a user input after previewing the electronic signature appearance and before electronically signing the electronic document;

The electronic signature appearance, *i.e.*, the visual manifestation of the signer's signature on the electronic document, can be edited by a user. The user can preview the electronic signature appearance and edit the appearance before electronically signing the electronic document.

The Examiner relies on Parry at paragraph 0038 as disclosing this limitation. Parry states: "The electronic signature module 322 is configured to control functions that manipulate

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(create, edit, append, delete, verify, etc.) the electronic signature 326 included with the electronic document 324.” The Examiner states that although previewing of the signature is not specifically disclosed, a signature must be previewed in order for a user to determine if an edit is desired [OA, p. 3, lines 3-5].

Aside from the sentence quoted above, there is no disclosure in Parry of editing an electronic signature, nor how such task would be undertaken and achieved. However, more importantly, the sentence above relied on by the Examiner is referring to functions that can manipulate the “electronic signature 326”. The electronic signature 326 is defined in Parry as including “a number of bits from which the user’s identity and the public key code 338 can be obtained”. Thus, if Parry is disclosing an edit function, it is to edit the electronic signature itself, not an electronic signature appearance, as is required by claim 1.

The applicant’s claim 1 is directed to a method for establishing an electronic signature appearance and, at the time of signing, previewing the electronic signature appearance such that the appearance may be edited by a user after previewing and before electronically signing the electronic document. Until the electronic document has been signed, there is no “electronic signature”, rather, there is just an electronic signature appearance. Thus, editing an electronic signature is not the same as editing an electronic signature appearance. Claim 1 recites a method where an electronic signature appearance can be previewed and edited before an electronic signature even exists; the electronic signature therefore need not be edited.

Parry discloses some techniques that can be used to sign a document, such as a user signing a paper document that is subsequently scanned to create the electronic document; a user signing a paper document that is positioned on top of an electronic pad and the signature recorded by the electronic pad; and a user signing a digital pad that creates and stores a physical representation of the signature (para 0045). There is no disclosure in Parry as to the user editing any of these signature types.

Further, there is no disclosure of a previewing of the signature in a bounding region on the electronic document. Although the Examiner relies on Kuo for disclosing a bounding region, even Kuo does not disclose a “bounding region on the electronic document for the display of the

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electronic signature appearance". Kuo discloses displaying a test signature for a credit card transaction along with a template signature, so that a store clerk can visually compare the two and verify the test signature. There is no disclosure of a bounding region on an electronic document to be signed.

The applicant respectfully submits the Examiner has failed to show a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings" [MPEP, §2143]. Second, to establish a case of *prima facie* obviousness, "there must be a reasonable expectation of success". Third, "the prior art reference (or references when combined) must teach or suggest all the claim limitations" [MPEP, §2143].

For at least the reasons discussed above, the prior art references neither alone nor in combination teach or suggest all the claim limitations. As discussed, at least the second and third limitations are not taught or suggested, as neither reference discloses "determining a bounding region on the electronic document for the display of the electronic signature appearance" nor an "electronic signature appearance" that "can be edited based on a user input after previewing the electronic signature appearance and before signing the electronic document". Accordingly, claim 1 is in condition for allowance. Claims 2-16 depend from claim 1 and are therefore allowable for at least the same reasons.

Claims 17-32

Claim 17 recites a computer program product including instructions operable to cause a programmable processor to, amongst other things, determine a bounding region on an electronic document to be signed for the display of an electronic signature appearance, and at the time a user is signing an electronic document, to display a preview of the electronic signature appearance in the bounding region. The electronic signature appearance can be edited based on a user input after displaying the preview and before signing the electronic document. For at least the reasons discussed above in reference to claim 1, neither the Parry nor Kuo references, alone or in combination, disclose these limitations of claim 17. Accordingly, a *prima facie* case of

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obviousness has not been established and claim 17 is in condition for allowance. Claims 18-32 depend from claim 17 and are therefore allowable for at least the same reasons.

By responding in the foregoing remarks only to particular positions taken by the examiner, the applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the applicant's arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist.

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Respectfully submitted,

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